



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Patrick VOHLGEMUTH et al.

Group Art Unit: 2834

Application No.: 10/613,075

Examiner: Y. COMAS

Filed: July 7, 2003

Docket No.: 116444

For: AN ALTERNATOR

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A Notice of Appeal is filed herewith. Applicants respectfully request review of the Rejection Mailed November 16, 2005 in the above-identified application.

Claims 1 and 3-15 are pending in this application. No amendments are being filed with this request. This review is requested for the following reasons.

I. The Office Action includes a clear factual error as to the teachings of the applied reference

With respect to the rejection of claims 1, 10-12 and 15 under 35 U.S.C. §102(b) over U.S. Patent No. 5,283,490 to Nolte et al. (Nolte), Applicants pointed out in the September 20, 2005 Amendment that Nolte specifically teaches at col. 4, lines 28-31 that the end brackets 10, 11 (allegedly corresponding to the air inlet grid and the air outlet grid recited in claim 1) are secured to the main frame 9 (allegedly corresponding to the casing recited in claim 1) by bolt units 8 including through bolts 19, 20, 21 and 22. Therefore, in Nolte, the main frame 9 and the end brackets 10, 11 are not integrally cast. Accordingly, the September 20, 2005 Amendment argued that Nolte does not disclose that a casing includes at least one air inlet grid and at least one air outlet grid, both of which are made integrally with the casing, and that the casing is made as a casting, as recited in independent claim 1.

The Response to Arguments section of the November 11, 2005 Final Rejection states that Applicants' arguments are not persuasive "because Nolte disclose[s] that in accordance with the teaching of the present invention, the standard dynamoelectric machine is constructed with integrally cast or otherwise formed ventilating openings in the end brackets of the dynamoelectric machines" (col. 2, lines 30-40). However, in this passage, Nolte only teaches that the ventilating openings may be integrally cast in the end brackets. Nolte does not teach or suggest that the end brackets are integrally cast in the frame, as discussed above. Nolte's end brackets are secured to the main frame by the bolt units. Thus, the Patent Office's understanding of Nolte's teaching is incorrect, and as previously argued, Nolte does not teach or suggest the features recited in claim 1.

Nolte discloses a frame 9 with end brackets 10, 11 bolted thereto. Claim 1 recites that the casing is of elongate shape and a rotor is capable of turning inside the casing. Further, the casing includes at least one air inlet grid and one air outlet grid made integrally with the casing. In Nolte, the end brackets 10, 11 are not of elongate shape, and the rotor 13a does not turn inside the end brackets 10, 11, rather it rotates within the frame 9. Thus, because Applicants' casing includes at least one air inlet grid and at least one air outlet grid, the main frame of Nolte cannot be construed as casing within the terms of the claim. Further, because the casing as claimed is of an elongate shape and the rotor is capable of turning inside the casing, the end brackets 10, 11 of Nolte, in which are formed the ventilating openings, cannot be construed as being the casing as the end brackets 10, 11 do not meet the language of the claim. Thus, the Office Action interpretation of a casing, particularly one which is made as a casting, fails on all counts and is clear error.

Therefore, Applicants respectfully assert that this rejection is erroneous and request reconsideration and withdrawal of this rejection.

II. The Office Action rejects claims based on clear legal and factual error

With respect to the rejection of claims 1 and 14 under 35 U.S.C. §102(b) over JP No. 56049648 A to Kayane, the Office Action asserts that the feature "the casing is made as a casting" is a method of forming a device that is not germane to the issue of patentability of the device itself, and that the limitation has not been given patentable weight. This feature was originally recited in apparatus claim 2, which was properly considered by the May 20, 2005 Office Action, and is now incorporated in independent apparatus claim 1. The original claim 2 was not rejected over Kayane.

Applicants respectfully submit that this feature clearly limits the structure of the casing, which is well understood by those skilled in the art. That is, the feature specifies that the casing is a cast body. A cast body as found in Applicants' invention is clearly identified structurally by a metallographic examination, for example, which enables one to know the material used for making the casing, and by a surface analysis, which enables one to know the surface condition due to the mold. However, even without using such a metallographic examination or a surface analysis, one skilled in the art is able to distinguish upon viewing a piece made as a casting from a piece made from a sheet, as in Kayane where brackets 2 and 3a are fit to a housing 1 (abstract and Figures). As such, this is indeed a structural feature, and thus, patentable weight must be given. MPEP §2113 states that process steps should be considered when... the manufacturing process steps... impart distinctive structural characteristics... see, e.g., *In re Garnaro*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979)... holding terms such as "welded,"... "press fitted,"... are capable of construction as structural limitations.)" A casing made as a casting certainly qualifies as a structural feature. Thus, the Office Action's position is improper.

Therefore, Applicants respectfully asserts that the rejection is erroneous and request reconsideration of this rejection. Further, because original claim 2 was not previously rejected in the May 20, 2005 Office Action over Kayane, as described above, and as discussed in the September 20, 2005 Amendment, Applicants respectfully request withdrawal of the rejection.

III. The Office Action's alleged motivations for combining references are improper.

Applicants respectfully submit that the Office Action rejects claims under 35 U.S.C. §103(a) over various combinations of references. However, the alleged motivation for the combinations is improper as discussed below. That is, the Patent Office's alleged motivation is based on desirability in a vacuum. In order to establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention (MPEP §2143.01). However, such desirability is nowhere taught or suggested by any of the applied references. These rejections are entirely based on impermissible hindsight knowledge gained from Applicants' disclosure. Accordingly, the Patent Office fails to establish a *prima facie* case of obviousness. As such, these rejections are improper. Further, reasons why the combinations do not create a *prima facie* case of obviousness are found on pages 5 and 6 of the September 20, 2005 Amendment.

The Office Action rejects dependent claim 3 under 35 U.S.C. §103(a) over Nolte in view of U.S. Patent No. 4,908,538 to Geberth, Jr. et al. (Geberth). The Office Action's alleged motivation for combining these references is "since that would have been desirable for providing a casing made of high heat conducting material" (emphasis added).

The Office Action rejects claims 4 and 5 under 35 U.S.C. §103(a) over Nolte in view of U.S. Patent No. 3,730,642 to Barnstead et al. (Barnstead). Again, the Office Action's alleged motivation for combining these references is "since that would have been desirable in order to fix the end shield to the housing" (emphasis added).

The Office Action rejects claims 6 and 7 under 35 U.S.C. §103(a) over Nolte and Barnstead, in view of U.S. Patent No. 5,717,272 to Gobled. Again, the Office Action's alleged motivation for combining these references is "since that would have been desirable in order to provide a brush support easily replacing and cleaning of the commutator" (emphasis added).

The Office Action rejects claim 8 under 35 U.S.C. §103(a) over Nolte in view of U.S. Patent No. 5,182,482 to Burke. Again, the Office Action's alleged motivation for combining these references is "since that would have been desirable to permit coolant air to exit from the interior of the housing" (emphasis added).

The Office Action rejects claim 9 under 35 U.S.C. §103(a) over Nolte in view of U.S. Patent No. 9286086 to Behrend. Again, the Office Action's alleged motivation for combining these references is "since that would have been desirable to provide direction of the air flow" (emphasis added).

The Office Action rejects claim 13 under 35 U.S.C. §103(a) over Nolte in view of U.S. Patent No. 6,144,137 to Engelbert. Again, the Office Action's alleged motivation for combining these references is "since that would have been desirable [to] reduce the acoustic noise during operation of the motor assembly" (emphasis added).

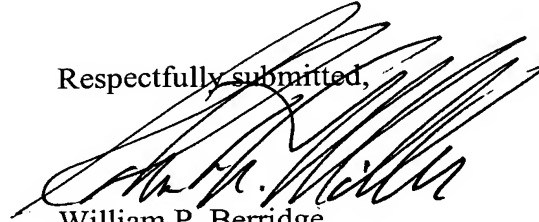
As discussed above, there is no showing of desirability in any applied reference. Thus, the alleged motivation is based on impermissible hindsight knowledge gained from Applicants' disclosure and, the rejections are improper. Applicants respectfully request withdrawal of the rejections.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1 and 3-15 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachments:

Petition for Extension of Time
Notice of Appeal

Date: March 16, 2006

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